

REMARKS

I. General

Claims 1-53 are pending in the present application and have been amended. Claims 54-58 have been added. Applicant thanks the Examiner for the indication that claim 31 would be allowable if rewritten in independent form.

II. Response to Examiner's Interview Summaries

A. Interview of November 15, 2006

Applicant thanks the Examiner for granting the telephone interview conducted on November 15, 2006. During that interview, claim 1 was discussed in light of the references of record. Applicant explained the invention to the Examiner, and the Examiner suggested that the claims be amended to make certain features more clear. The Examiner also agreed to informally review Applicant's proposed claim amendment, which Applicant faxed to the Examiner on December 7, 2006. The Examiner indicated that he would respond to the proposed amendment soon thereafter (*see* sub-heading B below).

B. Interview of December 8, 2006

The Examiner telephoned Applicant on December 8, 2006 to discuss the proposed amendment and stated that the claims would not be allowable in view of U.S. Patent Application Publication No. 2004/0022237 (*Elliott*) and U.S. Patent Application Publication No. 2002/0071537 (*Gainsboro*). Applicant respectfully disagrees with the Examiner's position, and has filed the present Amendment Accompanying a Request for Continued Examination. The present Amendment contains claims similar to those proposed on December 7, 2006.

III. Claim Amendments and New Claims

Claim 1 has been amended to more clearly recite subject matter that Applicant considers to be inventive. Particularly, claim 1 now recites that telephones are connected to an offsite public switched telephone network only under control of a programmable control

computer. The offsite public switched telephone network and the VoIP network, previously claimed as separate elements, are now used in the claim to indicate how certain connections are made. No new matter has been presented as the subject matter recited in claim 1 is found in the specification, for example, on pages 3-5 and Figures 1, 4, and 5.

Claim 12 has been amended to more clearly recite subject matter that Applicant considers to be inventive. Particularly, claim 12 now recites a switch operable under control of a programmable control system for selectively connecting telephones with an offsite public switched telephone network via a Voice over Internet Protocol (VoIP) network, wherein the telephones are connected to the VoIP network only under control of the programmable control system. No new matter has been presented as the subject matter recited in claim 12 is found in the specification, for example, on pages 3-5 and Figures 1, 4, and 5.

Claim 26 has been amended to more clearly recite subject matter that Applicant considers to be inventive. Particularly, claim 26 now recites a VoIP gateway for translating signals from telephones into data packets transmitted over a VoIP network to an offsite public switching network only under control of said control computer. No new matter has been presented as the subject matter recited in claim 26 is found in the specification, for example, on pages 3-5 and Figures 1, 4, and 5.

Claim 31 has been rewritten in independent form, as previously suggested by the Examiner, to overcome the objection of record. No new matter has been added.

Claim 32 has been amended to more clearly recite subject matter that Applicant considers to be inventive. Particularly, claim 32 now recites a plurality of telephone terminals disposed at a prison facility wherein access to the plurality of telephone terminals is provided by the prison facility, and a processor-based system providing call control for controlling restricting communications between the plurality of telephone terminals and user terminals external to the prison facility according to rules established by the prison facility. No new matter has been presented as the subject matter recited in claim 32 is found in the specification, for example, on pages 3-5 and Figures 1, 4, and 5.

Claim 43 has been amended to more clearly recite subject matter that Applicant considers to be inventive. Particularly, claim 43 now recites interfacing a telephone terminal of said prison telephone system coupled to a VoIP gateway with a public switched telephone network under control of a centralized system to restrict a call between the telephone terminal of said prison telephone system and a telephone terminal coupled to the public switched telephone network such that the telephone terminal of said prison telephone system is connected to the telephone terminal coupled to the public switched telephone network only under control of the centralized system. No new matter has been presented as the subject matter recited in claim 43 is found in the specification, for example, on pages 3-5 and Figures 1, 4, and 5.

Claims 2-11, 13-25, 27-30, 33-42, and 44-53 have been amended in light of the amendments to claims 1, 12, 32, and 43, and to correct informalities discovered during prosecution of the present application. No new matter is presented. Moreover, these amendments do not narrow the scope of the claims, but rather present previously recited terms more clearly.

Claims 54-58 have been added by the present amendment. Particularly, claim 54 contains subject matter originally claimed in canceled claims 19 and 20, and claims 55-58 contain subject matter originally claimed in claim 31. Accordingly, no new matter has been added. Applicant believes that claims 54-58 are patentable over the references of record, at least, for the reasons presented below.

IV. The Claim Rejections

Applicant has presented arguments and evidence which shows that the claims, as previously presented, were patentable over the prior art of record. *See* Amendment of April 6, 2006. Nonetheless, the Examiner has maintained the rejections set forth in the Final Office Action mailed September 14, 2006. Without conceding the propriety of those rejections, Applicant has amended the claims in order to expedite issuance of the present application.

Moreover, Applicant respectfully reminds the Examiner that:

[i]n order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

M.P.E.P. § 707.07(f). Accordingly, Applicant presents the arguments below in support for the patentability of the pending claims in light of previously applied art and rejections, and respectfully requests that the Examiner respond to each of these remarks, should similar rejections be re-raised, in a subsequent Office Action.

A. The Combination of *Kung '558* with *Gainsboro* is Improper

Claims 1, 2, 4, 6, 7, and 26 were previously rejected under 35 U.S.C. § 103 as being unpatentable over a combination of U.S. Patent Application No. 2003/0133558 to Kung et al. (hereinafter *Kung '558*) with U.S. Patent Application No. 2002/0071537 to Gainsboro (hereinafter *Gainsboro*). See e.g., Final Office Action, page 3. Applicant respectfully asserts that the Examiner has not provided the requisite motivation for the proposed combination.

Particularly, the Examiner has stated that it would have been obvious to restrict usage by particular individuals in *Kung*'s system in order "to mitigate harassment problems." Final Office Action, page 5. However, *Kung '558* discloses the implementation of a call waiting feature in a generic packetized network, whereas *Gainsboro* discloses a telecommunication apparatus for use in institutional environments. See e.g., *Kung '558*, Abstract; *Gainsboro*, Abstract. Clearly, the problems discussed in *Gainsboro* are specific to institutional environments, and as such do not exist in *Kung*. *Gainsboro*, paragraph [0002]. Simply put, there is no motivation to solve "harassment problems" in *Kung '558*. Therefore, there is no motivation to add elements of *Gainsboro* into *Kung '558* to address the aforementioned problems.

The Examiner has also stated that call restriction capability *can be* implemented by combining the institutional telephone system of *Gainsboro* with *Kung '558*'s IP central station (200). Final Office Action, page 5. However, the mere fact that references *can be* combined or modified does not render the resultant combination obvious unless the prior art

also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01.

Applicant respectfully disagrees with the proposition that elements of *Gainsboro* and *Kung '558* can indeed be combined, as proposed by the Examiner. Specifically, *Kung '558* IP central station (200) interfaces with a packetized communication system via an IP network (120). *Kung '558*, Figure 1. Meanwhile, *Gainsboro's* computer or CCU (3) controls telephone access in a public switched telephone network (PSTN) or plain old telephone service (POTS) environment via a trunk management unit or TMU (2) based upon DTMF tones captured by TMU (2). *Gainsboro*, paragraphs [0014]-[0016]; Figure 1. In contrast with *Gainsboro's* system, *Kung's* IP central station (200) does not interact with telephones, and it does not exchange messages with a trunk management unit, such as *Gainsboro's* TMU (2). *Kung '558*, paragraphs [0042]-[0077]. Therefore, adding *Gainsboro's* CCU (3) into *Kung '558's* IP central station (200) would require a substantial reconstruction and redesign of the elements shown in *Kung '558*.

In addition, Applicant respectfully reminds the Examiner that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959), *cited in* M.P.E.P. § 21.43.01(VI). In this case, *Kung '558* provides a communications system that allows the free exchange of telephone calls, messages, and the like. *Kung '558*, paragraphs [0026] and [0037]; Figure 1. In fact, *Kung '558's* operates to “expand[] the scope of traditional PSTN call waiting services by allowing a subscriber to be on one call and receive and place in a call queue, multiple [other] calls” *Kung '558*, paragraph [0011]. Clearly, *Kung '558's* main goal is to expand (not restrict) telephone calls being made. So, because the proposed combination of *Gainsboro's* telephone restrictions with *Kung '558's* system would change the principle of operation of *Kung '558* the teachings of the applied references are not sufficient to render the claims obvious.

B. The Application of *Kung* '558's to "Prison Facilities" is Improper

In support for the prior rejection of claims 32, 33, 36, 41-43, 47, 48, 52, and 53, the Examiner has asserted that, because *Kung* '558 discloses a system may be deployed in "a business or other location," *Kung* '558's system may also be used in a "prison facility." Final Office Action, pages 9-11. Even assuming, *arguendo*, that prison facilities are encompassed by *Kung* '558's "other locations," that alone is not sufficient to establish a prima facie case of obviousness. Applicant respectfully asserts that a genus does not ordinarily anticipate a claim to a species within the genus. See M.P.E.P. § 2131.02. Here, Applicant respectfully asserts that *Kung* '558's system would not be suitable for use in a prison facility, which presents unique challenges unlike those found in a generic location. See *e.g.*, Specification, page 2, lines 6-15; page 3, line 8—page 4, line 9. Therefore, although *Kung* '558's system may be deployed in "a business or other location," there is no indication that its system would be successfully implemented in a "prison facility."

C. Several Other Combinations of References Have Been Improperly Made

The Examiner has admitted that *Kung* '558 does not teach or suggest various limitations of several claims, and has previously attempted to cure those deficiencies by introducing combinations of *Kung* '558 with other prior art references. Final Office Action, pages 6-15. However, the Examiner has not properly established sufficient motivation for the combinations used in support of these rejections. For example, the Examiner has stated that:

- With respect to the combination of *Kung* '558 with *Cell* (U.S. Pat. No. 6,876,647), "[t]he motivation for using VoIP gateway in IP central station is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source." Final Office Action, page 6;
- With respect to the combination of *Kung* '558 in view of *Kung* '469 (U.S. Pat. No. 6,816,469), "[t]he motivation for using VoIP is to establish a voice call connection and receiving audio data from a network source." Final Office Action, page 8;

- With respect to the combination of *Kung* '558 in view of *Kung* '360 (U.S. Pat. No. 6,687,360), “[t]he motivation for using VoIP is to identify the caller and establish a voice call connection and receiving audio data from a network source.” Final Office Action, pages 11 and 12;
- With respect to the combination of *Kung* '558 with *Cell* and *Weitz* (U.S. Pat. No. 6,445,682), “[t]he motivation for using packetization is to establish a voice call connection with a VoIP gateway; and receiving audio data from a network source.” Final Office Action, page 13; and
- With respect to the combination of *Kung* '558 with *Kung* '469 and *Minert* (U.S. Pat. Pub. No. 2002/0141386), “[t]he motivation for using VOIP is to establish a VOIP telephone calling.” Final Office Action, page 15.

These stated motivations are, at best, only statements that the references can be combined. As noted above, the mere fact that references *can be* combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990), *cited in* M.P.E.P. § 2143.01.

Furthermore, several of these statements are circular in nature, merely stating that it is obvious to make the proposed combinations because it is obvious to achieve the result—*e.g.*, “[t]he motivation for using VOIP is to establish a VOIP telephone calling.” Again, these are only statements that the references *can be* combined, and do not state any desirability for making the combinations. In addition, Applicant respectfully points out that *Kung* '558 already provides VoIP functionality, and thus there is no need to add other references’ teachings to *Kung* '558 for the purpose of “using VoIP,” “establishing a VoIP telephone call,” or the like.

D. Unexpected Results

The coupling of a control computer for restricting usage of telephones placing and/or receiving calls using a VoIP network as set forth in the claims has been found to provide unexpectedly improved operational properties. As set forth in detail in the Declaration of Robert L. Rae attached hereto, use of a control computer for restricting usage of telephones

for calls using a VoIP network provides unexpected improvements with respect to numerous control features used in restricting telephone usage. Such evidence that the claimed invention yields unexpectedly improved properties is evidence of the non-obviousness of the claimed invention, see e.g., *In re Dillon*, 16 U.S.P.Q.2d 1897, 1902 (Fed. Cir. 1990).

V. Conclusion

In view of the above, Applicant believes the pending application is in immediate condition for allowance. Accordingly, Applicant requests that the pending claims be passed to issue.

Applicant believes no fee is due with this Response beyond the RCE fee addressed in the accompanying RCE and/or Transmittal(s). However, if any additional fee is due, please charge Deposit Account No. 06-2380, under Order No. 63134/P026US/10400589 from which the undersigned is authorized to draw.

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Respectfully submitted,

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